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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/732,408	12/09/1996	JOHANNES REINMULLER	HUBR1099PFFM	7906

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EXAMINER
PELLEGRINO, BRIAN E

ART UNIT	PAPER NUMBER
3738	

DATE MAILED: 07/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 08/732,408	Applicant(s) REINMULLER, JOHANNES
	Examiner Brian E Pellegrino	Art Unit 3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 March 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *43-48 and 50-103* is/are pending in the application.

4a) Of the above claim(s) *43-48 and 50-75* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *76-103* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Continued Prosecution Application

The request filed on 11/15/01 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/732408 is acceptable and a CPA has been established. An action on the CPA follows.

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I: folded sheet.

Species II: concentrically rolled sheet.

Species III: plurality of strands.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, none are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include

all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with James Crawford on 7/3/02 a provisional election was made without traverse to prosecute the invention of Species III, claims 76-103. Affirmation of this election must be made by applicant in replying to this Office action. Claims 43-48,50-75 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the implant of "spaghetti-like strands" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 90,95,97,98,102,103 are rejected under 35 U.S.C. 102(b) as being anticipated by Ledergerber (EP 322194). Figs. 3 and 8 show "strands of material" used for an implant. Ledergerber discloses that silicone filaments or "strands" can be used in the implant, col. 9, lines 28-32. Ledergerber also discloses that foam can be used in the implant, col. 4, lines 8-18. The surface is fully capable of being "wettable by a fluid lubricant". It has been held that the recitation that an element is "capable of", i.e. "wettable by fluid" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Ledergerber additionally discloses that an x-ray contrast medium can be incorporated into the material, col. 12, lines 53-58. Since the surface is covered with PTFE, it is inherent that it is hydrophobic, since PTFE is hydrophobic.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 76,81,83,84,88,89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ledergerber. Ledergerber is explained supra. Ledergerber discloses the claimed invention except for a thickness for the strands of material in the range of 10-200μm. It would have been an obvious matter of design choice to vary the thickness of the filaments or strands of Ledergerber, since such a modification would have involved a mere change in the size of the component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Claims 82,96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ledergerber in view of Perry et al. (5282857). Ledergerber is explained supra. However, Ledergerber does not disclose a fat or oil as a lubricant. Perry et al. teach that fats or oils in the form of glycerides are used in implants, col. 3, lines 1-4. It would have been obvious to one of ordinary skill in the art to use a fat or oil that wets a surface of the implant as taught by Perry with the implant of Ledergerber in order to reduce friction in the implant.

Claims 77-80,85,86,91-94,99,100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ledergerber in view of Taylor (4657553). Ledergerber is explained supra. However, Ledergerber does not disclose a hydrophilic surface and the use of a polysaccharide as part of the implant material. Taylor teaches that polysaccharides and a hydrophilic material are used in constructing the soft tissue implant, col. 1, lines 55-59. Taylor also discloses that the material is "swellable" or gelable and is "wettable by fluid" by mixing with an aqueous solution, col. 2, lines 61-64. It would have been obvious to one of ordinary skill in the art to use a polysaccharide as part of the implant material as taught by Taylor in the implant of Ledergerber because of the suitability of these materials as soft tissue implants.

Claims 87,101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ledergerber in view of Chapman (4348329). Ledergerber is explained supra. However, Ledergerber does not disclose Cuprophane as the implant material. Chapman teaches that polymers or "plastic" used in implants have coatings that are biocompatible, col. 6, lines 32-36,49-54 and cuprophane is one material used (col. 13, lines 9,12). It would have been obvious to one of ordinary skill in the art to use cuprophane as an implant material as taught by Chapman for the implant of Ledergerber in order to reduce cell membrane damage.

Response to Arguments

Applicant's arguments with respect to new claims 76 and 90 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached on Monday-Thursday from 9am to 6:30pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

CORRINE McDERMOTT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

Brian E. Pellegrino

TC 3700, AU 3738
July 12, 2002

Brian E Pellegrino